

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte M. MICHAEL PITTS, JR.
AND RODRIGO V. ROMO

Appeal 2007-0417
Application 10/796,814
Technology Center 1700

Decided: May 11, 2007

Before EDWARD C. KIMLIN, CHUNG K. PAK, and THOMAS A. WALTZ, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's refusal to allow claims 1 through 3, all of the claims pending in the above-identified application. We have jurisdiction pursuant to 35 U.S.C. § 6.

I. APPEALED SUBJECT MATTER

The subject matter on appeal is directed to a method for preventing the formation of biofilm deposits in water treatment systems “by the application of a capacitive electrostatic device (Specification 1, paragraphs 0002 and 0003).” Further details of the appealed subject matter are recited in illustrative claim 1 reproduced below:

1. A method for reducing the formation of biofilm deposits on a wall in a water system comprising the steps of:

providing a capacitive electrostatic generator adapted to create an electrostatic field;

immersing said electrostatic generator in a body of water in the water system, the water system being connected to an electrical ground relative to an electromotive force available for energizing the electrostatic generator; and

energizing said electrostatic generator with said electromotive force, such that a corresponding electrostatic field is created between said generator immersed in the water system and said electrical ground without measurable current leakage in the body of water;

wherein said capacitive electrostatic generator comprises a vitrified ceramic tube of unibody construction having an integrally-sealed end defining an inner cavity with an inner wall; conductive material contained within said inner cavity and disposed in intimate contact with said inner wall; electrically sealing means for providing hermetic closure to said inner cavity; and electrical means for energizing said conductive material with a static electromotive force.

II. EVIDENCE RELIED UPON BY THE EXAMINER

The Examiner has relied upon the following sole reference as evidence of unpatentability:

Pitts, Jr. (Pitts) US 5,591,317 Jan. 7, 1997

III. REJECTION

The Examiner has rejected claims 1 through 3 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Pitts.

IV. DISCUSSION

As evidence of anticipation of the subject matter defined by claims 1 through 3 under 35 U.S.C. § 102(b), the Examiner has relied on the disclosure of Pitts (Answer 3). The Examiner has found that Pitts describes the claimed method, except for the claimed result, i.e., biofilm deposit reduction (Answer 3). According to the Examiner (*id.*), such result would inherently or necessarily occur in Pitts' method since Pitts employs the claimed apparatus and the claimed conditions and parameters to reduce scale or sludge in a water system as discussed and claimed by the Appellants.

The Appellants do not dispute that Pitts, like the Appellants, employs the claimed apparatus and the claimed conditions and parameters to reduce scale or sludge in a water system (Br. 4-6 and Reply Br. 2-3). Compare also Pitts' water system at columns 1-3 with the Appellants' water systems at pages 1-6 of the Specification. Thus, notwithstanding the Appellants' arguments to the contrary in the Reply Brief¹, we find that the claimed

¹ In any event, this argument was not timely raised in the opening Brief and is considered waived. *See Cross Med. Prods., Inc. v. Medtronic Sofamore*

result, i.e., reducing the formation of biofilm deposits, would necessarily or inherently occur in the method taught by Pitts.

The Appellants contend that the present application is entitled to the benefit of the filing date of Pitts under 35 U.S.C. § 120, thus removing Pitts as a reference against the claims on appeal (Br. 4-6). According to the Appellants (Reply Br. 2-3), this entitlement is supported by the Examiner's admission that Pitts provides inherent written descriptive support for the missing claimed preamble limitation, i.e., reducing the formation of biofilm deposits.

The Examiner has recognized (Answer 3-4) that:

[I]nstant application SN 10/796,814 is a continuation of [application] SN 10/047,493 (abandoned), which is a continuation-in-part of [application] SN 09/416,255 (abandoned), which is a continuation-in-part of [application] SN 09/167,115 (abandoned), which is a continuation-in-part or [sic] [application] SN 08/779,819 (issued as patent number 5,817,224); which is a continuation-in-part of [application] SN 08/197,154 (issued as patent number 5,591,317[Pitts]).

However, the Examiner has taken the position that the present application is not entitled to the benefit of the filing date of Pitts since it and the other applications in the priority chain do not expressly describe reducing the formation of biofilm deposits within the meaning of 35 U.S.C. § 112, first paragraph (Answer 4). In other words, the Examiner has determined that Pitts is available as "prior art" within the meaning of 35 U.S.C. §102(b) contrary to the Appellants' contention (*id.*).

Danek, Inc., 424 F.3d 1293, 1320-21 n.3, 76 USPQ2d 1662, 1683 n.3 (Fed. Cir. 2005). Thus, we need not consider this argument.

The dispositive question is, therefore, whether Pitts is available as “prior art” within the meaning of 35 U.S.C. 102(b). On this record, we answer this question in the affirmative.

35 U.S.C. § 120 (Nov. 29, 1999) states in relevant part:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

To obtain the benefit of the filing date of an earlier application, this statute requires that, *inter alia*, the subject matter claimed in the present application must be supported by the written description provided in the earlier application within the meaning of 35 U.S.C. § 112, first paragraph. *In re Wilder*, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1994), *cert. denied*, 469 U.S. 1209 (1985). The subject matter claimed in the present application can find written descriptive support either explicitly or inherently in the earlier application. *Kennethcott Corp. v. Kyocera Int'l Inc.*, 835 F.2d 1419, 1421-23, 5 USPQ2d 1194, 1196-98 (Fed. Cir. 1987). However, in order for the present application to be entitled under 35 U.S.C. § 120 to the filing date of Pitts in the chain of applications of which it is a part, “it must be shown that as to the inventions claimed there has been [a] ‘continuing disclosure through the chain of applications, without hiatus.’”

Lemelson v. TRW, Inc., 760 F.2d 1254, 1266, 225 USPQ 697, 706 (Fed. Cir. 1985)(citation omitted). In other words, the Appellants have the burden of establishing that each application in the chain either inherently, implicitly or expressly provides written descriptive support for the claimed subject matter of the present application within the meaning of 35 U.S.C. § 112, first paragraph, in order to obtain the filing date of Pitts. *See also In re Ziegler*, 992 F.2d 1197, 1200, 26 USPQ2d 1600, 1603 (Fed. Cir. 1993) (The burden of establishing entitlement to the filing date of a previously filed foreign application is on the applicant.); *Langer v. Kaufman*, 465 F.2d 915, 913, 175 USPQ 172, 174 (CCPA 1972) (“To prove inherency, the burden is on appellants to show that the ‘necessary and only reasonable construction to be given the disclosure by one skilled in the art is one which will lend clear support to....[this] positive limitation...’”).

Here, the Appellants may have established that Pitts inherently describes the subject matter claimed in the present application within the meaning of 35 U.S.C. § 112, first paragraph. But, the Appellants have not demonstrated that each application in the chain inherently describes the subject matter claimed in the present application or contains Pitts’ inherent disclosure relied upon by the Examiner (Br. 4-6 and Reply Br. 2-3). The Appellants simply have not identified any written description in each intervening application in the chain that satisfies the written description requirement of the first paragraph of § 112. As such, we determine, on this record, the Appellants have not shown that “there has been [a] ‘continuing disclosure [of the claimed invention] through the chain of applications, without hiatus’” as required by *Lemelson, supra*. Accordingly, we concur with the Examiner that the subject matter claimed in the present application

is not entitled to the benefit of any filing dates of the intervening applications in chain, much less the filing date of Pitts.

In addition to the written description requirement under § 112, the statute also requires the present application to provide “a specific reference” to an earlier application. In other words, the present application needs to refer to all the applications in the chain, including Pitts, if it is to obtain the filing date of Pitts. *Sticker Indus. Supply Corp. v. Blaw-Knox Co.*, 405 F.2d 90, 92-93, 160 USPQ 177, 178-79 (7th Cir. 1968). However, the Appellants’ present application states in the “CROSS-REFERENCE TO RELATED APPLICATIONS” section (Specification 1) that:

This application is a continuation application of copending U.S. Serial No. 10/047,493, filed January 14, 2002, which was a CIP application of U.S. Ser. No. 09/416,255, filed October 12, 1999, abandoned.

The present application does not refer to the other applications in the priority chain, including Pitts. Thus, even if the subject matter claimed in the present application is described by the chain of applications, we determine that the present application is, at best, entitled to the filing date of Application 09/416,255 (October 12, 1999). *See Sticker Indus. Supply Corp. v. Blaw-Knox Co., supra.* As Pitts’ publication or issuance date is still more than one year before the filing date of Application 09/416,255, the Appellants cannot remove Pitts as a prior art reference against the claims on appeal.

The Appellants contend that “[n]o case law or statutory authority stand[s] for the proposition that an applicant’s parent application itself can be used to anticipate a child application....” (Br. 5) This contention is

devoid of any merit. As explained by our reviewing court in *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991):

The CCPA also recognized a subtle distinction between a written description adequate to *support* a claim under § 112 and a written description sufficient to *anticipate* its subject matter under § 102(b). The difference between “claim-supporting disclosures” and “claim-anticipating disclosures” was dispositive in *In re Lukach*, 442 F.2d 967, 169 USPQ 793 (CCPA 1971), where the court held that a U.S. “grandparent” application did not sufficiently describe the later-claimed invention, but that the appellant’s intervening British application, a counterpart to the U.S. application, anticipated the claimed subject matter. As the court pointed out, “the description of a single embodiment of broadly claimed subject matter constitutes a description of the invention for anticipation purposes..., whereas the same information in a specification might not alone be enough to provide a description of that invention for purposes of adequate disclosures....”

Consistent with the holding of *Lukach*, our reviewing court in *In re Chu*, 66 F.3d 292, 297, 36 USPQ2d 1089, 1093 (Fed. Cir. 1995) held that an applicant’s parent application was available as prior art against the claims of its child application.

The Appellants contend that “the selective application by the Examiner of “inherent disclosure” to find anticipation yet deny priority has no basis in patent law (Br. 5).” This contention, however, is incorrect in the context of the present circumstance. As indicated *supra*, the Appellants have not demonstrated that “there has been [a] ‘continuing disclosure [of the claimed subject matter] through the chain of applications, without hiatus’” as required by *Lemelson, supra* and “a specific reference” to all the applications in the chain, including Pitts, in the present application as required by *Sticker Indus. Supply Corp. v. Blaw-Knox Co., supra*.

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Having determined that the subject matter claimed in the present application is not entitled to the filing date of Pitts or any other filing dates of the intervening applications in the chain, we concur with the Examiner that Pitts would have rendered the claimed subject matter anticipated within the meaning of 35 U.S.C. § 102(b).

V. ORDER

The Examiner's decision rejecting the claims on appeal under 35 U.S.C. § 102(b) is affirmed.

AFFIRMED

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